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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,716	11/19/2003	Subhash Harmalker	IR6029-01	6320

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EXAMINER

DELCOTTO, GREGORY R

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,716

Applicant(s)

HARMALKER, SUBHASH

Examiner

Gregory R. Del Cotto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14 are pending. Applicant's amendments and arguments filed 11/1/04 have been entered. Note that, the prior art rejections as set forth below are the same as the prior art rejections affirmed by the Board of Appeals in a decision rendered on 7/26/02.

Objections/Rejections Withdrawn

2. The following objections/rejections set forth in the Office action mailed 5/3/04 have been withdrawn:

None. However, the Examiner incorrectly stated the secondary references as "Baravetto" and "Inman" in the rejection line in the Office action mailed 5/3/04. This has been corrected by listing "Pyles" and "Bolich, Jr. et al" as set forth below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zocchi (US 5,681,801) in view of Pyles (US 5,576,279) or Bolich, Jr. et al (US 5,104,646).

Zocchi teaches a combination cleansing, conditioning composition comprising a stable, clear, aqueous cleaning phase having stably dispersed and suspended therein particles bearing the conditioning agent, the aqueous cleaning phase comprising a high foaming anionic surfactant, an amphoteric surfactant in quantities of at least 0.2 weight percent of the composition wherein the clarity of the aqueous phase is maintained, and an effective amount of a viscoelasticity enhancing system suspending material comprised of a xanthan gum having an initial transmittance in a 1 wt% distilled water solution of at least 85% as measured by a UV spectrophotometer at 600 nanometers. See Abstract. Examples of suitable anionic surfactants include alkyl sulfates, alkyl sulfonates, alkyl ether sulfates, etc., in which the alkyl chain contains from 8 to 20 carbon atoms. The anionic surfactants can be alkoxyated, preferably ethoxyated and are generally present in quantities of at least 2% by weight. See column 2, lines 14-20. Suitable amphoteric surfactants include cocoamido propyl or ethyl betaines. See column 2, lines 40-56. Additionally, a nonionic surfactant is optionally included in the composition in amounts from 0.75% to about 7% by weight. See column 3, lines 15-20.

The composition provides a unique method for delivering conditioning agents to the skin and hair. The particles suspended in the aqueous cleansing phase bear on and/or inside their surface conditioning agents such as emollients, anti-oxidants, vitamins, mineral oils, vegetable oils, and any other oil like material applied to the skin

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or hair for conditioning effect. Preferably, the particle size of the particulate suspended phase bearing the conditioning agent is from about 200 to about 2500 microns. See column 3, line 45 to column 4, line 15. The particle size of the xanthan gum material used in the compositions are such that 100% goes through 60 mesh (250 micron) screen. See column 4, lines 40-55. The xanthan gum should be present from about 0.3% to about 1% by weight of the composition. See column 5, lines 1-15.

However, Zocchi does not teach a personal cleansing composition containing hydroxypropyl guar gum nor specifically teach a personal aqueous cleansing/conditioning composition containing an anionic surfactant, an amphoteric surfactant, a suspending material mixture comprised of xanthan gum and guar gum and particles bearing a conditioning agent suspended in an aqueous phase in the specific proportions as recited by the instant claims.

Pyles teaches a conditioning shampoo containing an anionic surfactant, a long-chain fatty alcohol, and a cationic polyethyleneimine which has extended product stability, excellent cleansing and foaming properties, and provides excellent and improved overall conditioning to human hair, particularly superior wet and dry combing properties. See Abstract. Additionally, Pyles teaches that to provide exceptionally stable emulsification of water-insoluble conditioning agent and to aid in thickening and foam stability, suspending and thickening agents such as xanthan gum, guar gum, etc., can be used in the composition in an amount from 0.1% to 5% by weight of the composition. See column 6, lines 58-69.

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Bolich, Jr. et al teach a vehicle system which provides a desirable rheology to products formulated therewith, enhanced dispersion of actives therein, and improved deposition of actives therefrom. The vehicle system comprises a primary thickening agent and a water-soluble surfactant dispersed in compatible solvent. These vehicle systems are useful in cosmetic compositions which are used to deliver an active component to the hair or skin. The vehicle systems are particularly useful in hair care compositions, especially rinse-off hair conditioning compositions, because they effectively deliver the hair conditioning component to the hair without depositing a substantial amount of the vehicle material onto the hair. See Abstract. The vehicle systems will also comprise an additional thickening component, which comprises a water-soluble polymeric material. By water-soluble polymer is meant that the material will form substantially a clear solution in water at a 1% concentration at 25 degrees Celsius and the material will increase the viscosity of the water. Preferred as the optional additional thickener for the present vehicle systems are natural polysaccharide materials such as guar gum, locust bean gum and xanthan gum. The additional thickening component, if present in the cosmetic compositions, is included in an amount from about 0.3% to about 5.0% by weight. See column 12, line 55 to column 13, line 25.

It would have been obvious to one of ordinary skill in the art to use guar gum in place of a portion of xanthan gum as a thickening agent in the hair cleansing/conditioning composition taught by Zocchi having the same physical parameters as the xanthan gum taught by Zocchi with the expectation of success since

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Pyles or Bolich, Jr. et al teach the equivalence of xanthan gum to guar gum as thickening agents in similar hair care compositions. Note that, an express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Also, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Note that, Applicant has demonstrated no criticality with respect to a mixture of xanthan gum and guar gum as the thickening agent.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a personal aqueous cleansing/conditioning composition containing an anionic surfactant, an amphoteric surfactant, a suspending material mixture comprised of xanthan gum and guar gum and particles bearing a conditioning agent suspended in an aqueous phase in the specific proportions as recited by the instant claims since the broad teachings of Zocchi in combination with Bolich, Jr. et al encompass a personal aqueous cleansing/conditioning composition containing an anionic surfactant, an amphoteric surfactant, a suspending material mixture comprised of xanthan gum and guar gum and particles bearing a conditioning agent suspended in an aqueous phase in the specific proportions as recited by the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,681,801 in view of Pyles (US 5,576,279) or Bolich, Jr. et al (5,104,646). Claims 1-14 of US 5,681,801 recite a personal cleansing/conditioning composition encompassing all the material limitations of instant claims 1-14 except for the inclusion of guar gum.

Pyles or Bolich, Jr. et al teach similar personal cleaning compositions which show the equivalence of xanthan gum to guar gum as thickening agents.

It would have been obvious to one of ordinary skill in the art to use guar gum in place of a portion of xanthan gum as a thickening agent in the hair cleansing/conditioning composition claimed by Zocchi having the same physical parameters as the xanthan gum taught by Zocchi with the expectation of success since Pyles or Bolich, Jr. et al teach the equivalence of xanthan gum to guar gum as thickening agents in similar hair care compositions.

Note that, instant claims 1-14 of US 5,681,801 (Zocchi) in view of Pyles or Bolich, Jr. et al encompass the material limitations of instant claims 1-14.

Response to Arguments

With respect to Zocchi, Applicant states that Zocchi does not teach the use of hydroxypropyl guar gum and the other components of the composition as recited by the instant claims. In response, note that, the instant claims do not require the presence of hydroxypropyl guar gum.

With respect to Zocchi, Applicant states that Zocchi mentions xanthan gum as the stabilizing viscoelastic material but says nothing about further materials that can be employed together with the xanthan gum and that it is clear from the Zocchi disclosure that numerous other potential stabilizing, thickening materials were tried and were not effective for the dual goal of maintaining clarity as well as a stable dispersion and suspension of the particles. Furthermore, Applicant states that there is no teaching either alone or in combination of the cited references of how to achieve the clear composition of the present invention with a dual gum system.

In response, note that, the fact that Zocchi is silent with respect to other suspending materials which can be used in conjunction with xanthan gum does not mean that one of ordinary skill in the art would not be motivated to use other suspending materials or that other materials amongst a large number of conventionally used and well-known suspending agents would not be useful. In fact, as discussed below, the Examiner maintains that one of ordinary skill in the art would be motivated to use a suspending agent such as guar gum in addition to xanthan gum in the compositions taught by Zocchi from the teachings of Zocchi in combination with Pyles or Bolich, Jr. et al.

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With respect to Pyles or Bolich, Jr. et al, Applicant states that neither Pyles or Bolich, Jr. et al, Applicant states that these references are not pertinent because they do not teach clear compositions. In response, note that, the Examiner maintains that Zocchi **teaches clear compositions**. Pyles or Bolich, Jr. et al are secondary references drawn to similar personal cleansing composition which teach the equivalence of guar gum to xanthan gum as thickening and suspending agents. Since Pyles or Bolich, Jr. et al teach the equivalence of guar gum to xanthan gum as suspending agents in personal cleansing compositions and Zocchi teaches the use of xanthan gum in a similar personal cleansing composition, the Examiner maintains that one of ordinary skill in the art, with a reasonable expectation of success, would have been motivated to use a guar gum of similar size to the xanthan gum taught by Zocchi in the cleansing composition taught by Zocchi. Note that, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). See MPEP 2144.06.

Additionally, the rejections as set forth above were affirmed by the Board of Appeals in a decision rendered on 7/26/02 on claims which are substantially identical to the instant claims.

Conclusion

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4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory R. Del Cotto

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Primary Examiner
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GRD

January 24, 2005